Docket No.: 042390.P9622

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of:<br>Julie J. Bennett<br>Application No.: 09/650,362<br>Filed: August 29, 2000<br>For: METHOD AND APPARATUS FOR VISUAL BROWSING | Examiner: Leslie Wong<br><br>Art Group: 2167 |

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits the following Appeal Brief pursuant to 37 C.F.R. § 41.37 for consideration by the Board of Patent Appeals and Interferences. This is an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner of group Art Unit 2167, dated November 30, 2004 in which claims 1, 3-12, 14-23, and 25-33 were finally rejected. Appellant also submits herewith our check number 31573 in the amount of $950.00 to cover the cost of filing the opening brief as required by 37 C.F.R. § 1.17(c) and a petition for a two month extension of time. Please charge any additional fees or credit any overpayment to our deposit Account No. 02-2666. A duplicate copy of the Fee Transmittal is enclosed for this purpose.

## TABLE OF CONTENTS

## I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Intel Corporation.

## II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellant, the Appellant's legal representative, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## III. STATUS OF CLAIMS

Claims 1, 3-12, 14-23, and 25-33 of the present application are pending and remain rejected. The Appellant hereby appeals the rejection of claims 1, 3-12, 14-23, and 25-33. A copy of claims 1, 3-12, 14-23, and 25-33 as they stand on appeal are set forth in the Appendix.

## IV. STATUS OF AMENDMENTS

No amendments to the claims have been made after the receipt of the Final Office Action of November 30, 2004. Further, the Examiner issued an Advisory Action on February 15, 2005 further delineating her reasons for rejecting the claims.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

1. Independent claims 1, 12, and 23:

Appellant's invention as in claims 1, 12, and 23 generally relate to a method, machine readable medium, and an apparatus. Utilizing apparatus claim 23 as an example, an apparatus shown as service provider 107 includes a service provider computer system 108 having a processor 110 and a memory 140 coupled to the processor in which the memory stores a visual browser 109 and in which a network interface 135 couples the service provider computer system 108 to a computer network 106.[1] Upon a user logging on to the virtual store, the virtual browser 109 via the computer network 106 displays a random assortment of products 301, 306, 308, 310, 312, 314, 316, 318, etc. to the user

[1] Specification, pages 7-8, Figures 1-2.

associated with the virtual store without regard to a user profile.[2] Further, upon set-up, the visual browser creates a plurality of categories in which each category identifies an attribute or certain trait that will be used to identify a product and products having at least one attribute are associated with the at least one category that identify the attribute.[3] Upon the selection of a main product 310 by a user in communication with the visual browser via the computer network, the visual browser displays a plurality of related products 330, 332, 334, 336, etc. having at least one attribute in common with the main product that is selectable for purchase by the user.[4]

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 3-12, 14-23, and 25-33 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,317,222 issued to Jacobi et al. (hereinafter Jacobi) in view of U.S. Patent No. 6,125,353 issued to Yagasaki (hereinafter Yagasaki).

## VII. ARGUMENTS

### A. Claims 1, 3-12, 14-23 and 25-33 Are Not Rendered Obvious Over Jacobi in View Yagasaki

Claims 1, 3-12, 14-23, and 25-33 are not rendered obvious over Jacobi in view of Yagasaki.

#### 1. Independent Claims 1, 12, and 23 Are Not Rendered Obvious By Jacobi in View of Yagasaki.

Independent claims 1, 12, and 23 stand or fall together. Independent claim 1 will be used as the representative claim.

In the Advisory Action set forth by the Examiner on February 15, 2005, the Examiner maintained her rejection that independent claims 1, 12, and 23 are rendered obvious by Yagasaki in view of Jacobi. Applicant respectfully submits that the Examiner is in error and respectfully requests that the Board reverse this finding.

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[2] Specification, page 12, lines 10-20, Figure 3A.
[3] Specification, page 17, lines 22-24 and page 18, lines 1-9, Fig. 5; see also Specification, page 12, lines 2-4.
[4] Specification, page 13, lines 7-21, Figure 3B.

As the Examiner notes in the Advisory Action: "Jacobi does not explicitly teach upon a user logging on to a virtual store having a visual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store without regard to a user's profile…Yagasaki, however, teaches 'upon a user logging on to a virtual store having a virtual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store without regard to a user profile' as a mall server which provides a virtual shopping mall on a network…The mall server classifies online products into a plurality of categories to help consumers to search for the desired products…The products that fall under the selected category are then displayed on the screen or customers terminal…" (See Advisory Action, page 2) (Emphasis Added).

Appellant respectfully submits that independent claims 1, 12, and 23 are not rendered obvious by the combination of Jacobi and Yagasaki because Jacobi and Yagasaki are not properly combinable, and even if they were properly combinable, Yagasaki does not teach the limitation of "displaying a random assortment of products to the user associated with the virtual store without regard to a user profile"; for which the Examiner erroneously asserts that it teaches.

Appellant respectfully submits that in the Examiner's Advisory Action, the Examiner has not rebutted Appellant's argument as to why Jacobi teaches away from its combination with Yagasaki and further has not shown that Yagasaki actually teaches the limitation for which the Examiner asserts that Yagasaki teaches.

Thus, Appellant respectfully submits that Jacobi is not properly combinable with Yagasaki because Jacobi teaches away from Appellant's claim limitations of independent claims 1, 12, and 23 and further, the intended function of Jacobi would be destroyed by the combination. Therefore, there is no motivation to combine Jacobi with Yagasaki. Further, even in Jacobi and Yagasaki were properly combinable, their combination would still not teach the limitations of Applicant's independent claims 1, 12, and 23.

Appellant's independent claims 1, 12, and 23 generally relate to: *upon a user logging onto a virtual store having a virtual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store without regard*

*to a user profile*...creating a plurality of categories, each category identifying an attribute...associating products having at least one attribute with at least one category...and upon selection of a main product by a user in communication with the visual browser, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user. (Emphasis Added).

Appellant respectfully submits that Jacobi *teaches away* from displaying a random assortment of products to the user associated with the virtual store *without regard to a user profile*.

With regards to obviousness, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

> Most if not all inventions arise from a combination of old elements. Thus every element of a claimed invention may often be found in the prior art. *However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. (Emphasis added).

Further, references are not combinable when one of the references *teaches away* from the invention as set forth in the claims. As will be discussed, Jacobi teaches away from Appellant's claim limitations. As stated in the MPEP [i] t is improper to combine references where the references *teach away* from their combination" MPEP § 2145 (emphasis added).

As further set forth in the MPEP:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)
>
> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Appellant respectfully submits that Jacobi and Yagasaki are not combinable because Jacobi *teaches away* from their combination and, in fact, the proposed modification of Jacobi would destroy the intended purpose of Jacobi.

As set forth in MPEP § 2145.X.D and 2143.01, when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness cannot be properly made. This has consistently been held by the Federal Circuit.

Jacobi teaches a service that recommends products or other items to a user based on a set of items *known to be of interest to the user*, such as a set of items currently in the user's electronic shopping cart (e.g., see Abstract, lines 1-4, Emphasis Added). In fact, Jacobi's function and purpose is aptly described in its title: "Use of Electronic Shopping Carts to Generate Personal Recommendations."

In describing the problem with past recommendation systems Jacobi states that "existing systems do not provide a mechanism for recognizing that the user may be searching for a particular type or category of item." (Column 2, lines 26-29).

To solve this problem, Jacobi teaches that "the service identifies items that are currently in the user's shopping cart, and uses these items to generate a list of additional items that are predicted to be of interest to the user..." (Abstract).

The fundamental purpose of Jacobi to provide an improved recommendation system based upon products that are known to be of interest to the user, would be completely destroyed, if it were to be combined with Yagasaki to try to render Appellant's claims obvious.

Quite clearly, Jacobi *teaches away* from the limitations of Appellant's independent claims 1, 12, and 23 that recite upon a user logging on to a virtual store having a virtual

browser via computer network, a random assortment of products are displayed to the user associated with the virtual store *without regard to a user profile*.

Moreover, combining Jacobi with Yagasaki in an attempt to teach Appellant's claim limitations *would destroy the intended function and purpose* of Jacobi.

Accordingly, Appellant respectfully submits that it is clear that because Jacobi *teaches away* from a combination with Yagasaki, and because a combination with Yagasaki would destroy Jacobi's intended purpose and function, that there is quite simply no motivation to combine Jacobi with Yagasaki. Therefore a prima facie case of obviousness cannot be properly made.

As the Examiner acknowledges in the previous Final Office Action and the Advisory Action, Jacobi does not teach upon a user logging on to a virtual store having a virtual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store without regard to a user profile. Therefore, because, as previously discussed, Jacobi is not properly combinable with Yagasaki, Appellant respectfully submits that independent claims 1, 12, and 23 are patentable and should be allowed.

Moreover, Appellant respectfully submits that, in fact, the very purpose for which Yagasaki is utilized by the Examiner, to allegedly teach displaying a *random assortment of products* to the user associated with the virtual store without regard to a user profile is inaccurate. Yagasaki does not actually teach these limitations.

The Examiner in the Final Office Action and the Advisory Action cites column 1, lines 29-40 and Figure 7 of Yagasaki for this teaching. However, looking particularly at column 1, lines 29-40, illustrates that Yagasaki teaches a product search screen which when opened by a customer presents a list of product categories such as "fashion," "gourmet," "hobby," "holiday season," and "gifts," which are listed as available search keys. As set forth in Yagasaki: "From this list, the customer selects one category that may include what he/she desires to buy…products that fall under the selected category are then displayed on the screen of a customer's terminal." (emphasis added). These category selection features are clearly shown in Figures 7 and 10 of Yagasaki.

Thus, as set forth above, Yagasaki teaches displaying product categories that may then be searched for particular products. Accordingly, Jacobi does not teach *displaying a random assortment of products upon a user logging on to a virtual store*, but only displaying a list of product categories that are then searchable.

Yagasaki does not teach displaying a random assortment of products to the user associated with the virtual store without regard to a user profile when the user logs on to the virtual store.

Thus, as previously discussed in detail, Jacobi is not properly combinable with Yagasaki, because Jacobi *teaches away* from a combination with Yagasaki and, further, the combination of Jacobi and Yagasaki would destroy *the intended function and purpose* of Jacobi. Moreover, as previously discussed, even if Jacobi and Yagasaki were combinable, their combination would still not teach or suggest the claim limitations of Appellant's independent claims 1, 12, and 23.

Accordingly Appellant respectfully submits that independent claims 1, 12, and 23 and their respective dependent claims are distinguishable and allowable over the cited prior art references.

## VIII. CONCLUSION

Appellant respectfully requests that the Board enter a decision overturning the Examiner's rejection of all pending claims, and hold that the claims are not rendered obvious by the prior art.

Respectfully submitted,

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## IX. CLAIMS APPENDIX

The claims of the present application which are involved in this appeal are as follows:

1. (Previously Presented) A method comprising:

upon a user logging on to a virtual store having a visual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store without regard to a user profile;

creating a plurality of categories, each category identifying an attribute;

associating products having at least one attribute with at least one category; and

upon selection of a main product by a user in communication with the visual browser, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.

2. (Canceled)

3. (Original) The method of claim 1, further comprising, displaying at least one other product that is not related by a category to the main product.

4. (Original) The method of claim 1, further comprising, assigning a weight bias to each category based upon a predefined importance of the respective category.

5. (Original) The method of claim 4, further comprising:

determining "like" categories for the main product, a "like" category being a category that the main product is associated with;

selecting one of the "like" categories; and

randomly selecting the at least one other related product from the selected "like" category.

6. (Original) The method of claim 5, wherein selecting one of the "like" categories includes utilizing the weight biases for the categories in a randomly based selection algorithm to select one of the "like" categories.

7. (Original) The method of claim 5, further comprising:

determining "dislike" categories for the main product, a "dislike" category being a category that the main product is not associated with;

selecting one of the "dislike" categories utilizing the weight biases for the categories in a randomly based selection algorithm; and

randomly selecting at least one other product from the selected "dislike" category.

8. (Original) The method of claim 5, further comprising:

selecting a category from the plurality of categories utilizing the weight biases of the categories in a randomly based selection algorithm; and

randomly selecting a product from the selected category.

9. (Original) The method of claim 1, further comprising:

scoring each product based upon weight biases of "like" categories and "dislike" categories, a "like" category being a category that the main product is associated with, a "dislike" category being a category that the main product is not associated with, a weight bias being a predefined value assigned to each respective category to denote the respective category's importance;

creating a "like" score table, the "like" score table including a "like" score for each of the products indicating the relatedness of the product to the main product; and

randomly selecting the at least one other related product from the "like" score table using the "like" scores as a weight bias.

10. (Original) The method of claim 9, further comprising:

creating a "dislike" score table, the "dislike" score table including a "dislike" score for each product indicating the unrelatedness of the product to the main product, the "dislike" score table being the transposition of the "like score table"; and

randomly selecting at least one other product from the "dislike" score table using the "dislike" scores as a weight bias.

11. (Original) The method of claim 10, further comprising, selecting at least one other product at random from one of the plurality of categories.

12. (Previously Presented) A machine-readable medium having stored thereon instructions, which when executed by a machine, causes the machine to perform operations comprising:

upon a user logging on to a virtual store having a visual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store without regard to a user profile;

creating a plurality of categories, each category identifying an attribute;

associating products having at least one attribute with at least one category; and

upon selection of a main product by a user in communication with the visual browser, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.

13. (Canceled)

14. (Original) The machine-readable medium of claim 12, further comprising the operation of displaying at least one other product that is not related by a category to the main product.

15. (Original) The machine-readable medium of claim 12, further comprising the operation of assigning a weight bias to each category based upon a predefined importance of the respective category.

16. (Original) The machine-readable medium of claim 15, further comprising the operations of:

determining "like" categories for the main product, a "like" category being a category that the main product is associated with;

selecting one of the "like" categories; and

randomly selecting the at least one other related product from the selected "like" category.

17. (Original) The machine-readable medium of claim 16, wherein the operation of selecting one of the "like" categories includes utilizing the weight biases for

the categories in a randomly based selection algorithm to select one of the "like" categories.

18. (Original) The machine-readable medium of claim 16, further comprising the operations of:

determining "dislike" categories for the main product, a "dislike" category being a category that the main product is not associated with;

selecting one of the "dislike" categories utilizing the weight biases for the categories in a randomly based selection algorithm; and

randomly selecting at least one other product from the selected "dislike" category.

19. (Original) The machine-readable medium of claim 16, further comprising the operations of:

selecting a category from the plurality of categories utilizing the weight biases of the categories in a randomly based selection algorithm; and

randomly selecting a product from the selected category.

20. (Original) The machine-readable medium of claim 12, further comprising the operations of:

scoring each product based upon weight biases of "like" categories and "dislike" categories, a "like" category being a category that the main product is associated with, a "dislike" category being a category that the main product is not associated with, a weight bias being a predefined value assigned to each respective category to denote the respective category's importance;

creating a "like" score table, the "like" score table including a "like" score for each of the products indicating the relatedness of the product to the main product; and

randomly selecting the at least one other related product from the "like" score table using the "like" scores as a weight bias.

21. (Original) The machine-readable medium of claim 20, further comprising the operations of:

creating a "dislike" score table, the "dislike" score table including a "dislike" score for each product indicating the unrelatedness of the product to the main product, the "dislike" score table being the transposition of the "like score table"; and

randomly selecting at least one other product from the "dislike" score table using the "dislike" scores as a weight bias.

22. (Original) The machine-readable medium of claim 21, further comprising the operation of selecting at least one other product at random from one of the plurality of categories.

23. (Previously Presented) An apparatus comprising:

a processor and a memory coupled thereto, the memory storing a visual browser;

a network interface to couple to a computer network;

upon a user logging on to a virtual store having the visual browser via the computer network, the visual browser,

displaying a random assortment of products to the user associated with the virtual store without regard to a user profile;

creating a plurality of categories, each category identifying an attribute;

associating products having at least one attribute with at least one category; and

upon selection of a main product by a user in communication with the visual browser via the computer network automatically causing the display of a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.

24. (Canceled)

25. (Original) The apparatus of claim 23, wherein the visual browser causes the display of at least one other product that is not related to the main product.

26. (Original) The apparatus of claim 23, wherein the visual browser assigns a weight bias to each category based upon a predefined importance of the respective category.

27. (Original) The apparatus of claim 26, wherein the visual browser:

determines "like" categories for the main product, a "like" category being a category that the main product is associated with;

selects one of the "like" categories; and

randomly selects the at least one other related product from the selected "like" category for display to the user.

28. (Original) The apparatus of claim 27, wherein selecting one of the "like" categories includes utilizing the weight biases for the categories in a randomly based selection algorithm to select one of the "like" categories.

29. (Original) The apparatus of claim 27, wherein the visual browser:

determines "dislike" categories for the main product, a "dislike" category being a category that the main product is not associated with;

selects one of the "dislike" categories utilizing the weight biases for the categories in a randomly based selection algorithm; and

randomly selects at least one other product from the selected "dislike" category for display to the user.

30. (Original) The apparatus of claim 27, wherein the visual browser:

selects a category from the plurality of categories utilizing the weight biases of the categories in a randomly based selection algorithm; and

randomly selects a product from the selected category for display to the user.

31. (Original) The apparatus of claim 23, wherein the visual browser:

scores each product based upon weight biases of "like" categories and "dislike" categories, a "like" category being a category that the main product is associated with, a "dislike" category being a category that the main product is not associated with, a weight bias being a predefined value assigned to each respective category to denote the respective category's importance;

creates a "like" score table, the "like" score table including a "like" score for each of the products indicating the relatedness of the product to the main product; and

randomly selects the at least one other related product from the "like" score table using the "like" scores as a weight bias for display to the user.

32. (Original) The apparatus of claim 31, wherein the visual browser:

creates a "dislike" score table, the "dislike" score table including a "dislike" score for each product indicating the unrelatedness of the product to the main product, the "dislike" score table being the transposition of the "like score table"; and

randomly selects at least one other product from the "dislike" score table using the "dislike" scores as a weight bias for display to the user.

33. (Original) The apparatus of claim 31, wherein the visual browser selects at least one other product at random from one of the plurality of categories.